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COMMENTS

POSTHUMOUS RIGHT OF PUBLICITY: JURISDICTIONAL CONFLICT AND A PROPOSAL FOR SOLUTION

I. INTRODUCTION

The right of publicity, a term of art first coined by Judge Jerome Frank in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*,¹ is used to refer to the right of a person to exploit his own name and likeness. It has been characterized both as a personal property right² and as a right of value.³ While a right of publicity has no inherent value, it becomes "valuable" when a celebrity⁴ or his assign exploits the right by selling a product or service bearing the celebrity's name or likeness for profit. Whether the right of publicity is viewed as a property right or a right of value, the commercial exploitation of this right by a celebrity, athlete, writer or public figure can involve substantial sums of money.

The right of publicity is a creature of state law⁵ and has been codified by statute in California and New York.⁶ Though a living person may prevent the appropriation of his own name and likeness by another,⁷ not all jurisdictions recognize a cause of action brought

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1. 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

2. *See, e.g.,* Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978); Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y. 1975).

3. In *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979), the California Supreme Court stated, "the parties have extensively briefed and argued, that the interest in question is one of 'property' We agree, however, with Dean Prosser who considers a dispute over this question 'pointless' [citation omitted]. *Once protected by the law* [the right of a person to the use of his name and likeness] . . . is a right of value" 25 Cal. 3d at 818-19, 603 P.2d at 428, 160 Cal. Rptr. at 326 (quoting W. PROSSER, *LAW OF TORTS* 807 (4th ed. 1971)) (emphasis added by the court).

4. In this comment the term celebrity will be used in a generic sense to refer to movie and television personalities, professional athletes, musicians, actors, entertainers, public figures, and the like.

5. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

6. *See infra* notes 23-24 and accompanying text.

7. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 578 (1977).

by the heirs or assigns of a famous ancestor to enjoin posthumous commercial exploitation by a third party who sells merchandise bearing the deceased celebrity's name and likeness.

This lack of uniformity among the jurisdictions regarding the posthumous right of publicity poses a number of intriguing questions. For example, do the laws of the state in which the deceased celebrity gained his fame and entered into merchandise licensing contracts govern the posthumous right of publicity? Or do the laws of the state where the harm occurred—the state in which the defendant merchandiser realized his greatest profits—govern? Whose law governs when the defendant merchandiser profits by exploiting a deceased celebrity's name and likeness in several states, some of which recognize the posthumous right of publicity, and some of which do not? Most importantly, does an injunction against a defendant merchandiser's commercial exploitation of a celebrity's right of publicity in one state prohibit the merchandiser from operating the same business in a jurisdiction that does not recognize a posthumous right of publicity? These questions have not yet been resolved.

This comment reviews the jurisdictional split over the posthumous right of publicity, and focuses on California, New York, New Jersey, Tennessee and Georgia law, as these are the only jurisdictions in which posthumous right of publicity cases have been reported. It will analyze the questions posed and the conflict which arises in the interstate commercial exploitation of the posthumous right of publicity. Finally, the comment proposes that a uniform national act permitting a posthumous right of publicity where there has been an inter vivos assignment or devise evidenced by significant commercial exploitation be adopted.

II. THE HISTORY OF THE RIGHT OF PUBLICITY

A. *Origins*

The right of publicity originated in privacy law and is one of four distinct torts which protects the plaintiff's right "to be left alone."⁸ In their famous *Harvard Law Review* article, Warren and Brandeis advocated that the law recognize a person's right to be left alone and called this a "right of privacy."⁹ Dean Prosser later named the four privacy torts: intrusion, public disclosure of private facts,

8. The words "to be left alone" were first used in T. COOLEY, *LAW OF TORTS* 29 (2d ed. 1888).

9. Warren & Brandeis, *The Right to Privacy*, 4 *HARV. L. REV.* 193 (1890).

false light publicity and "[a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness."¹⁰ Appropriation is now commonly referred to as the right of publicity.

B. *The Right of Publicity: Living Persons v. Decedents*

As early as 1905, in *Pavesich v. New England Life Insurance Co.*,¹¹ the Georgia Supreme Court recognized a living person's right of publicity using a privacy analysis. In *Pavesich* the plaintiff's photograph was used by defendant life insurance company in an advertisement. The court held that this violation of the plaintiff's privacy entitled him to recover damages.¹² Similarly, in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*,¹³ a baseball player successfully enjoined a chewing gum company from using his photograph as a means of promoting the sale of defendant's gum and recovered damages under what the court called "a right of publicity."¹⁴

The United States Supreme Court held, in *Zacchini v. Scripps-Howard Broadcasting Co.*,¹⁵ that petitioner, a celebrity who performed a "human cannonball" act at county fairs, had a protectable right of publicity. In *Zacchini* defendant broadcaster filmed the petitioner's entire 15-second human cannonball act and broadcasted, on a television news program, the act in its entirety. *Zacchini* brought suit for damages alleging unlawful appropriation of his professional property.¹⁶ The Ohio Supreme Court agreed with petitioner that he had a right of publicity giving him "personal control" over commercial exploitation of his act, but held that the press was privileged to broadcast the performance.¹⁷ The United States Supreme Court reversed.¹⁸ The Court reasoned that *Zacchini* had economic value in his performance and the unauthorized use of the film affected his ability to earn a living as an entertainer. The Court concluded that, "[p]etitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it."¹⁹ The *Zacchini* analysis relied on the strictly *personal* right the petitioner had in his performance. No-

10. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

11. 122 Ga. 190, 50 S.E. 68 (1905).

12. *Id.*

13. 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

14. 202 F.2d at 868.

15. 433 U.S. 562.

16. *Zacchini v. Scripps-Howard Broadcasting Co.*, 47 Ohio St. 2d 224, 351 N.E. 2d 454 (1976), *rev'd*, 433 U.S. 562 (1977).

17. 47 Ohio St. 2d at 235, 351 N.E. 2d at 461.

18. 433 U.S. at 579.

19. *Id.* at 578.

where in the decision is there a suggestion that anyone other than Zacchini himself had the right to exploit, for commercial purposes, his name and likeness.

A decedent's right of publicity, and by extension, the right of his heirs to enforce this right, however, is in doubt. The Seventh Circuit Court of Appeals, in *Maritote v. Desilu Productions, Inc.*,²⁰ held that under Illinois law the right of privacy could not be asserted by anyone other than the person whose privacy is invaded. In *Maritote*, the administratrix of Al Capone's estate sued the television production company of the "The Untouchables" series for unjust enrichment in appropriating the name, likeness, and personality of the notorious gangster. Capone's widow and son brought a claim for invasion of privacy. The court observed that defendant's "'commercial exploitation' of decedent in commercially televised fictional broadcasts after his death" gave rise to both claims, and that both claims constituted an invasion of privacy.²¹ However, plaintiffs were denied relief because the court reasoned that "[i]t is anomalous to speak of the privacy of a deceased person."²²

C. *Statutes Recognizing A Right Of Publicity*

California and New York have statutory provisions which protect the right of publicity in living persons. In the New York statute, entitled Right of Privacy,²³ it is a misdemeanor to use the name or likeness of "any living person" for advertising or trade, without the written consent of that person. It is clear that this statute creates no right in a person's descendants or heirs to enjoin the use of an ancestor's name or likeness.

California's statutory right of publicity is found in section 3344 of the Civil Code²⁴ and is similar to the New York statute. The

20. 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 383 (1965).

21. 345 F.2d at 418-19.

22. *Id.* at 419, 420.

23. The New York statute provides:

A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

N.Y. CIV. RIGHTS LAW § 50 (McKinney 1976).

24. Section 3344 states:

(a) Any person who knowingly uses another's name, photograph, or likeness, in any manner, for purposes of advertising products, merchandise, goods or services, or for purposes of solicitation of purchases of products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages

statute, which is designated "use of name or photograph without consent for advertising," does not specifically use the term "living person" but its language leaves no doubt that only a living person

sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount no less than three hundred dollars (\$300).

(b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable.⁽¹⁾ A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.

(2) If the photograph includes more than one person so identifiable, then the person or persons complaining of the use shall be represented as individuals rather than solely as members of a definable group represented in the photograph. A definable group includes, but is not limited to, the following examples: a crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.

(3) A person or persons shall be considered to be represented as members of a definable group if they are represented in the photograph solely as a result of being present at the time the photograph was taken and have not been singled out as individuals in any manner.

(c) Where a photograph or likeness of an employee of the person using the photograph or likeness appearing in the advertisement or other publication prepared by or in behalf of the user is only incidental, and not essential, to the purpose of the publication in which it appears, there shall arise a rebuttable presumption affecting the burden of producing evidence that the failure to obtain the consent of the employee was not a knowing use of the employee's photograph or likeness.

(d) For purposes of this section, a use of a name, photograph or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for purposes of advertising or solicitation.

(e) The use of a name, photograph or likeness in a commercial medium shall not constitute a use for purposes of advertising or solicitation solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the complainant's name, photograph or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for purposes of advertising or solicitation.

(f) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television stations, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that such owners or employees had knowledge of the unauthorized use of the person's name, photograph, or likeness as prohibited by this section.

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

can bring this cause of action. Neither the California nor the New York statute creates a posthumous right of publicity in the heirs or assigns of a deceased celebrity.

D. *Restatement View*

Appropriation of name or likeness is recognized as a tort in the *Restatement (Second) of Torts*.²⁵ The right protected is the "interest of the *individual* in the exclusive use of his own identity" which is considered to be "in the nature of" a property right. The right of publicity is exercised or exploited during life when a person grants an exclusive license or assigns his publicity rights to a third party, who sells merchandise bearing his name and likeness. The third party who is the assignee of a person's right of publicity, may bring suit to protect the license or assignment.²⁶

The *Restatement* does not recognize a posthumous right of publicity in a decedent's heirs. At most, it recognizes an inter vivos assignment to a third party who will have standing to protect his license. An inter vivos assignment, it may be argued, will create a posthumous right of publicity in the assignee for the *particular* photograph or *particular* item of merchandise that is the subject of the assignee's license.²⁷ The *Restatement* does not contemplate the wholesale assignment or devise of a "generic" right of publicity to every likeness of the assignor for use with all products.

III. THE POSTHUMOUS RIGHT OF PUBLICITY: JURISDICTIONAL CONFLICT

A living person may thus maintain a suit for infringement of his right of publicity in New York and California, or by using the *Restatement* view for support in those jurisdictions where the legislature has yet to codify the right. However, the posthumous right of publicity in the heirs of a celebrity is not a statutory right, and may be sued upon only in those states which recognize the cause of action. A review of recent case law demonstrates that heirs or assigns may be able to enjoin a merchandiser's commercial exploitation of

25. "One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy." RESTATEMENT (SECOND) OF TORTS § 652C (1977).

26. RESTATEMENT (SECOND) OF TORTS § 652C comment a (1977).

27. For a detailed discussion of exploitation of particular commercial situations see, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 818, 822, 603 P.2d 425, 428, 430, 160 Cal. Rptr. 323, 326, 328 (1979).

their celebrity ancestor's name and likeness if the plaintiff is fortunate enough to bring suit in a jurisdiction which recognizes a posthumous right of publicity. So far, those jurisdictions are New York, New Jersey and Georgia only.

A. *The New York Cases*

In *Price v. Hal Roach Studios, Inc.*,²⁸ Harmon Pictures, a California corporation, sued Hal Roach Studios, a Delaware corporation with its principal place of business in New York, for appropriation of the world-wide, exclusive merchandising rights to the names and likenesses of the Laurel and Hardy comedy team. Harmon was joined in the suit by the widows and beneficiaries of the two comedians. Harmon had been party to an agreement between the comedian Stanley Laurel, Hardy's widow, Price, and the Laurel and Hardy production company, a California corporation, which granted Harmon "in perpetuity the exclusive right to utilize and merchandise" Laurel and Hardy's publicity rights. Defendant Roach Studios claimed to own copyrights to certain Laurel and Hardy movies, and had entered into an agreement purporting to convey merchandising rights to the names and likenesses of the comedians.²⁹

Despite the numerous California contacts, the case was decided on the basis of New York law.³⁰ The court found for the plaintiffs and held that there was no requirement that a person exercise his right of publicity in order to protect it from posthumous exploitation or to preserve the right for his heirs.³¹ It relied on *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*,³² a case that considered a living celebrity's right of publicity, to find that the right of publicity is an assignable property right that does not terminate on death.³³

It is difficult to understand how the court could conclude that a right of publicity, which had never been exploited during life, descends to one's heirs. The court reasoned that the New York statute protecting a person from commercial exploitation supported its holding that lifetime exploitation is unnecessary.³⁴ However, the New York statute protects the "living," and the person who is wronged must bring suit to protect his right. A decedent, obviously, cannot

28. 400 F. Supp. 836 (S.D.N.Y. 1975).

29. *Id.* at 838.

30. *Id.* at 843.

31. *Id.* at 846.

32. 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

33. 400 F. Supp. at 844.

34. *Id.* at 846.

protect his own right, and neither the New York statute nor the Restatement creates a descendible publicity right or a posthumous publicity right in all likenesses of decedent or in every merchandising opportunity, whether or not exploited.

In contrast to the decision in *Price v. Hal Roach Studios*, two later New York cases were decided in favor of defendants who had exploited deceased celebrities' rights of publicity. Both *Frosch v. Grosset & Dunlop, Inc.*³⁵ and *Hicks v. Casablanca Records*³⁶ relied on the traditional protections afforded to freedom of expression and carefully avoided the fact that the profit motive was responsible for defendants' literary and filmmaking endeavors.

Frosch and *Hicks* are anomalies in the line of decisions based on New York law. Though books and movies enjoy certain constitutional protections not generally accorded merchandise,³⁷ they are nonetheless profit-making endeavors and as such should be susceptible to injunction, under New York law, by heirs and assigns of a deceased celebrity. *Frosch* and *Hicks* raise the question of whether a posthumous right of publicity extends only to a commercial advertisement for the sale of goods or services such as posters, tee-shirts and bubblegum cards, but fails in the face of other commercial and profit-making ventures such as books and movies.

Most recently, in *Groucho Marx Productions, Inc. v. Day and Night Co.*,³⁸ the Second Circuit Court of Appeals examined the question of which state's law should govern in a right of publicity case. In the lower court the Marx Brothers' heirs, who claimed to own the publicity rights of comedians Groucho, Chico and Harpo Marx, sought a licensing fee in connection with the Broadway play "A Day in Hollywood/A Night in the Ukraine." The play featured performers who "reproduce[d] the appearance and comedy style made memorable by Groucho, Chico and Harpo."³⁹ The court

35. 75 A.D.2d 768, 427 N.Y.S.2d 828 (1980). In *Frosch*, plaintiff-executor of the estate of actress Marilyn Monroe sued defendant publisher and author Norman Mailer for infringement of Monroe's right of publicity in connection with the publication of the book *MARILYN*. The court held that freedom of expression outweighed the right of publicity of the decedent.

36. 464 F. Supp. 426 (S.D.N.Y. 1978). In *Hicks*, plaintiff heir and assignee of the publicity rights of mystery author Agatha Christie sought to enjoin defendants, filmmaker Casablanca and publisher Ballentine books, from showing the motion picture and distributing the book *AGATHA*, both of which concerned a fictional event in the life of the late writer. The court held that Christie's right of publicity had been properly assigned and survived her death, but held that the balance between freedom of expression and protection of the right of publicity militated in favor of freedom of expression. *Id.* at 430, 433.

37. *Hicks*, 464 F. Supp. at 430.

38. 689 F.2d 317 (2d Cir. 1982).

39. *Id.* at 319.

granted partial summary judgment for the heirs, ruling that the Marx brothers' performances as themselves were sufficient lifetime exploitation and therefore it was unnecessary for the comedians to "endorse dance studios, candy bars or tee-shirts."⁴⁰ The court concluded that any literary merit in the play was outweighed by the "wholesale appropriation of the Marx Brothers characters" and rejected defendants' contention that freedom of expression protected their rights to produce the play without paying damages to the plaintiffs.⁴¹

On appeal, the Second Circuit Court of Appeals held the "decision to look to the law of New York [to decide the case] was incorrect."⁴² The court stated that in deciding a right of publicity case, a New York court "would apply its property choice-of-law rules to select the state whose law" governs a posthumous right of publicity claim.⁴³ Thus, even though plaintiff's harm occurred in New York, California law governed because, among other things, the comedians were California residents at the time of their deaths, the Marx Brothers' production company executed various contracts assigning publicity rights which were governed by California law, and plaintiff Susan Marx was a California resident.⁴⁴

The court relied on *Lugosi v. Universal Pictures*⁴⁵ as establishing that California law did not recognize a posthumous right of publicity in the heirs of a celebrity who did not exploit his own right during his lifetime.⁴⁶ Thus, no posthumous right of publicity existed in the heirs of the Marx Brothers, and the producers of the Broadway play were not liable for a royalty or licensing fee.

B. The California Case

*Lugosi v. Universal Pictures*⁴⁷ is a landmark case in the area of

40. *Groucho Marx Prod., Inc. v. Day and Night Co.*, 523 F. Supp. 485, 492 (S.D.N.Y. 1981), *rev'd*, 689 F.2d 317 (2d Cir. 1982).

41. *Id.* at 493.

42. 689 F.2d at 319.

43. *Id.*

44. *Id.* at 320.

45. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

46. 689 F.2d at 321-23. Judge Newman concluded, however, that *Lugosi* was subject to a second interpretation, namely that California recognizes a posthumous right of publicity "only in connection with particular commercial situations—product and services—that a celebrity promoted during his lifetime." Under either interpretation, the court stated, the plaintiffs in *Groucho* could not prevail because California law would not recognize a posthumous right of publicity "that protects against an original play using a celebrity's likeness and comedic style." *Id.* at 323.

47. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

posthumous right of publicity. The actor, Bela Lugosi, contracted with Universal Pictures to play the title role in the film "Dracula." The contract gave Universal the exclusive right to exploit the actor's name and likeness in connection with the film. Lugosi's widow and son filed suit alleging that Universal had appropriated property they had inherited from Lugosi by entering into licensing agreements which authorized the licensees to commercially exploit the character of Dracula.⁴⁸ The trial court found that Lugosi had a protectable property right in his likeness and appearance as Count Dracula which descended to his heirs.⁴⁹ The Court of Appeal reversed and the California Supreme Court affirmed, adopting as its own the decision of the Court of Appeal.⁵⁰

The California Supreme Court reasoned that the dispute over whether the right of publicity was a property right was "pointless," and called it instead a "right of value" which Lugosi had neither exploited nor protected during his lifetime. The court held that the right of publicity "is embraced in the law of privacy and is protectable during one's lifetime but it does not survive the death of Lugosi."⁵¹ The court found support for its decision in privacy law, which unequivocally states that the right of privacy dies with the individual who can enforce his personal right. Just as privacy is a personal right, "[t]he very decision to exploit name and likeness is a personal one."⁵²

The *Lugosi* decision makes it clear that the "opportunity" to exploit a famous ancestor's right of publicity does not descend to the celebrity's heirs regardless of whether the celebrity exploited the right during his lifetime. "Assertions by the heirs of the right to exploit their predecessor's name and likeness to commercial situations he left unexploited simply is *not* the exercise of that right by *the person* entitled to it."⁵³

There is no question that *Lugosi* governs posthumous publicity rights in California. Two days after *Lugosi* was decided, the California Supreme Court cited it as authority in holding that no posthumous publicity rights existed in the heirs of silent movie actor Rudolph Valentino.⁵⁴ Thus, in California, there is no posthumous right

48. *Id.* at 816-817, 603 P.2d at 427, 160 Cal. Rptr. at 325.

49. *Id.* at 817, 603 P.2d at 427, 160 Cal. Rptr. at 325.

50. *Id.* at 816, 603 P.2d at 426, 160 Cal. Rptr. at 324.

51. *Id.* at 818-19, 603 P.2d at 428, 160 Cal. Rptr. at 326.

52. *Id.* at 821-22, 603 P.2d at 429-430, 160 Cal. Rptr. at 327-28.

53. *Id.* at 823, 603 P.2d at 431, 160 Cal. Rptr. at 329 (emphasis in original).

54. In *Guglielmi v. Spelling-Goldberg Prod.*, 25 Cal. 3d 860, 630 P.2d 454, 160 Cal.

of publicity.

C. Georgia Law

In *Martin Luther King, Jr. v. American Heritage Products*,⁵⁵ the Eleventh Circuit Court of Appeals certified questions regarding the right of publicity to the Georgia Supreme Court. The Court of Appeals asked if Georgia law recognized a distinct right of publicity, whether this right survived the death of its owner, and as such was inheritable and devisable, and whether the owner needed to commercially exploit the publicity right during life to insure a posthumous right vested in the owner's heirs.⁵⁶

In *King* defendant James E. Bolen developed the idea of marketing a plastic bust of Dr. King and formed defendant company, American Heritage Products, to manufacture the bust. Bolen sought the endorsement and participation of plaintiff Martin Luther King, Jr. Center for Social Change in the endeavor, but the Center refused. Bolen advertised the bust in *Ebony* magazine and in newspapers nationwide. Plaintiffs Coretta Scott King, Dr. King's widow, the Center for Social Change, and Motown Records, the assignee of the rights to some of Dr. King's copyrighted speeches, brought suit to enjoin Bolen's business activities. The federal district court held for the plaintiffs and defendant's appeal on the right of publicity issues resulted in the certification of questions to the Georgia Supreme Court.⁵⁷

The Georgia Supreme Court held that appropriation of a person's right of publicity was a tort in Georgia whether "the person whose name and likeness is used is a private citizen, entertainer, or . . . a public figure who is not a public official."⁵⁸ The court also held that the right of publicity is inheritable and assignable, and that a person need not exercise his publicity right during life to assure the survival of the right in his heirs.⁵⁹ Thus, Georgia appears to follow New York law.

Rptr. 352 (1979), the heirs of silent film star Rudolph Valentino sued defendant Spelling-Goldberg who exhibited a fictional account of Valentino's life on television, without obtaining the consent of the heirs. The heirs sought injunctive relief and damages on a right of publicity theory. The court held that *Lugosi* controlled the disposition of the case and denied relief to plaintiffs. *Id.* at 861, 603 P.2d at 455, 160 Cal. Rptr. at 353.

55. 694 F.2d 674 (11th Cir. 1983).

56. *Id.* at 674.

57. *Id.* at 675-76.

58. 250 Ga. 135, 296 S.E.2d 697, 703 (1982).

59. *Id.* at, 296 S.E.2d at 705-06.

D. *The Elvis Presley Cases*

More than any other group of cases, the Elvis Presley decisions illustrate the difficulties that arise when a celebrity's posthumous publicity rights in his heirs or assigns are determined by reference to the law of more than one jurisdiction. Since 1978, six Presley cases have been decided by the federal courts whose rulings were based on the law of three different states.

1. *Factors Etc., Inc. v. Pro Arts, Inc.*⁶⁰ (*Factors I*)

In *Factors I*, defendant Pro Arts, an Ohio corporation, purchased a photograph of the entertainer Elvis Presley from a staff photographer on the *Atlanta Journal* and produced a poster from that photograph. The poster bore the legend "In Memory" and the dates "1935-1977." Pro Arts informed plaintiff Factors, the exclusive licensee of Boxcar Enterprises, a Tennessee corporation controlled by Presley and his business associate Colonel Tom Parker, that it was distributing the Elvis poster to meet the public demand for memorabilia after the celebrity's death. The poster was distributed by co-defendant Stop and Shop Stores through its retail outlets in New York. Factors replied that it owned the exclusive right to Presley's name and likeness in connection with the sale and distribution of all merchandise, and threatened legal action if poster sales were not immediately discontinued.⁶¹

Rather than cease distribution, Pro Arts filed suit in the Northern District of Ohio for declaratory relief. Factors, upon learning it had been sued, instituted an action in the Southern District of New York and obtained a preliminary injunction against Pro Arts. Pro Arts perfected an interlocutory appeal.⁶² The Second Circuit Court of Appeals rejected Pro Arts' claims that the case should have been transferred to Ohio or stayed, pending the outcome of the Ohio action, and proceeded to the right of publicity claims.⁶³

The Court of Appeals found that New York law governed the duration of Presley's right of publicity and held that Boxcar's exclusive right to exploit Presley's right of publicity, because exercised during life, survived the celebrity's death. Thus the right had been validly transferred to plaintiff Factors.⁶⁴

60. 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

61. 579 F.2d at 217.

62. *Id.* at 217-18.

63. *Id.* at 218-19.

64. *Id.* at 220-22. Relying on *Haelen Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), the court reasoned that Presley had a property right in his name and

The *Factors I* decision follows the precedent set in New York by *Price v. Hal Roach Studios*.⁶⁵ Elvis Presley, like Laurel and Hardy in *Price*, had a property right in his name and likeness which survived his death. Presley had exercised his right of publicity during life by licensing Factors to commercially exploit his name and likeness through the sale of "Elvis merchandise." This commercial exploitation guaranteed that under New York law, Presley's assigns owned the celebrity's exclusive publicity rights posthumously.

2. *Memphis Development Foundation v. Factors Etc., Inc.*⁶⁶

In *Memphis Development* the Sixth Circuit Court of Appeals reached the opposite conclusion of the Second Circuit in *Factors I*. The Memphis Development Foundation, a non-profit Tennessee corporation, planned to erect a statue of Elvis Presley in downtown Memphis. The Foundation solicited public funds to pay for the sculpture, offering an eight-inch replica of the statue to contributors to the project. Factors brought suit, as it had in *Factors I*, to enjoin the Foundation from distributing the replica statue.⁶⁷

The sixth circuit held that the right of publicity was not inheritable and that it "should not be given the status of a devisable right, even where as here a person exploits the right by contract during life."⁶⁸ Thus, despite the exclusive license which Factor's held to Presley's right of publicity, the court held that under Tennessee law the right did not survive the celebrity's death and "the opportunity for gain shift[ed] to the public domain, where it is equally open to all."⁶⁹ The court based its decision on practical and policy grounds. The court reasoned that fame is simply a by-product of a strong personal motivation to create and achieve success in a particular field whereas the desire to exploit fame for the economic advantage of descendants is pale in comparison to the personal motivation for achievement. The court stated:

[Fame] usually depends on the communication of information about the famous person by the media. The intangible and

likeness which was transferable and survived the celebrity's death. "To hold that the right did not survive Presley's death, would be to grant competitors of Factors, such as Pro Arts, a windfall in the form of profits from the use of Presley's name and likeness . . . [and] the exclusive right purchased by Factors . . . would be rendered virtually worthless." 579 F.2d at 211.

65. 400 F. Supp. 836 (S.D.N.Y. 1975).

66. 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980).

67. 616 F.2d at 957.

68. *Id.* at 958.

69. *Id.* at 957.

shifting nature of fame and celebrity status, the presence of widespread public and press participation in its creation, the unusual psychic rewards and income that often flow from it during life and the fact that it may be created by bad as well as good conduct combine to create serious reservations about making fame the permanent right of a few individuals to the exclusion of the general public.⁷⁰

The court also addressed the practical problems that arise when a posthumous right of publicity is recognized. It raised, but left unanswered, such questions as how long the posthumous right should last, whether it was taxable, whether it interfered with First Amendment rights, whether it extended to public officials and public figures as well as to celebrities, and whether the type of product on which a posthumous right of publicity was exploited would make a difference in a court's decision to recognize the right.⁷¹

The economic policy considerations in *Memphis Development* are a significant departure from the other posthumous right of publicity cases. The court reasoned that fairness and efficiency militated in favor of the right of publicity being "regarded as a common asset to be shared, an economic opportunity available in the free market system."⁷²

3. *Factors Etc., Inc. v. Pro Arts, Inc.*⁷³ (*Factors II*)

Factors brought suit for a third time to protect its license. In *Factors II*, Factors moved for summary judgment on the merits after it had obtained a preliminary injunction against Pro Arts in *Factors I*, and after *Memphis Development* had been decided. Pro Arts asserted that *Memphis Development* collaterally estopped Factors from asserting it owned Presley's posthumous right of publicity. The district court rejected Pro Arts' contention and granted a permanent injunction from which Pro Arts appealed.⁷⁴ The Second Circuit Court of Appeal reversed, stating that a New York court would look to the law of Tennessee in resolving the dispute.⁷⁵ The circuit court stated that because Presley was domiciled in Tennessee and Factors had contracted for its license there, and because the contract provided

70. *Id.* at 959.

71. *Id.*

72. *Id.* at 960.

73. 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982).

74. 456 U.S. at 280.

75. *Id.* The court noted that in *Factors I* the parties did not discuss choice of law rules, and the *Factors I* court applied New York law "without discussion." *Id.* That choice of law rule did not, however, preclude the present court from examining the point upon appeal. *Id.*

it was to be construed in accordance with the laws of that state, Tennessee law must govern.⁷⁶

In a well reasoned opinion, Judge Newman stated that were he serving on the Tennessee Supreme Court, he would recognize a posthumous right of publicity. However, the issue in this case was whether the federal court decision in *Memphis Development*, which interpreted the law of a state within its own circuit, should be regarded as an authoritative interpretation of that state's law by the federal courts in other circuits. Judge Newman reasoned that the second circuit should defer to the sixth circuit's ruling on the issue unless there was clear indication that the sixth circuit's ruling had been incorrect. Thus the court accepted *Memphis Development* as controlling authority, and found that the licensor "had no right of publicity in Presley's name and likeness to convey to Factors."⁷⁷

4. *Factors Etc., Inc. v. Pro Arts, Inc.*⁷⁸ (*Factors III*)

In *Factors III* Pro Arts moved for summary judgment and an assessment of damages against Factors on the basis of the second circuit's decision in *Factors II*. Factors filed a cross motion for summary judgment citing *Commerce Union Bank v. Coors*⁷⁹ in support of its motion. In the alternative, Factors requested that the court stay entry of judgment in *Factors III* so that it could petition the second circuit to recall its mandate and rehear the case on the basis of the decision rendered by the Tennessee Chancery Court in *Commerce Union Bank*.⁸⁰

In *Commerce Union Bank* the executor of the estate of Lester Flatt, a bluegrass musician,⁸¹ brought suit against the defendant, a distributor of Coors beer, for infringement of the celebrity's right of publicity in connection with Coor's use of Flatt's image on an advertising poster. Defendant Coors, who used Flatt's likeness along with that of President Andrew Jackson on a sales poster, neither sought permission from the estate to use Flatt's likeness, nor paid any royalties to the estate for the use of Flatt's likeness.⁸²

The court held that Flatt had a posthumous right of publicity,

76. *Id.* at 281.

77. *Id.* at 283.

78. 541 F. Supp. 231 (1982).

79. 7 MEDIA L. REP. (BNA) 2204 (1981).

80. 541 F. Supp. at 233.

81. Flatt was best known for his collaboration with musician Earl Scruggs. Flatt and Scruggs appeared on television together at the Grand Old Opry and composed the theme music for the "Beverly Hillbillies" television program and the motion picture "Bonnie and Clyde."

82. 7 MEDIA L. REP. (BNA) at 2205.

and noted that the right of publicity had not yet been recognized in Tennessee. However, since other intangible property rights had received recognition, the court stated that the Tennessee Supreme Court would undoubtedly recognize the right of publicity "when presented with an appropriate case."⁸³ The court relied on *Sanford-Day Iron-Works v. Enterprise Foundry & Machine*,⁸⁴ as support for finding the right of publicity to be a descendible property right. The court dismissed *Memphis Development* and *Factors II* as not binding on its decision, and stated that consideration of fundamental fairness and the public policy "to provide an incentive for enterprise and creativity by allowing individuals to benefit from their personal efforts"⁸⁵ controlled the disposition of the case.⁸⁶

On the basis of *Commerce Union Bank*, the district court in *Factors III* granted Factor's motion to stay entry of judgment.⁸⁷ It determined that the *Commerce Union Bank* decision was entitled to proper regard even though it was a Tennessee Chancery Court decision which did not bind the federal courts. The court was persuaded by the fact that both *Memphis Development* and *Factors II* were decided in the absence of any Tennessee case to use as guidance and granted the stay in light of the fact that the first Tennessee state court case to address the issue held that a posthumous right of publicity does exist.⁸⁸

5. *Factors Etc., Inc. v. Pro Arts*⁸⁹ (*Factors IV*)

In *Factors IV* the Second Circuit Court of Appeals denied Factors' petition for a rehearing to assess the decision by the Tennessee Chancery Court in *Commerce Union Bank*. The Court of Appeals stated that it was not necessary to decide whether *Commerce Union Bank* was authoritative as against the sixth circuit's decision in *Memphis Development Foundation v. Factors Etc., Inc.*

The court relied on *Lancaster v. Factors Etc., Inc.*,⁹⁰ another

83. *Id.*

84. 130 Tenn. 669, 172 S.W. 537 (1915). In *Sanford-Day Ironworks*, the court held that the exclusive right to use a trade name can survive the termination of business by the business entity which used it.

85. 7 MEDIA L. REP. (BNA) at 2208 (quoting Felcher & Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death*, 89 YALE L.J. 1125, 1129 (1980)) [hereinafter cited as Felcher & Rubin II].

86. 7 MEDIA L. REP. (BNA) at 2208.

87. 541 F. Supp. at 234.

88. *Id.*

89. *Factors Etc., Inc. v. Pro Arts*, 701 F.2d 11 (2d Cir. 1983).

90. 9 MEDIA L. REP. (BNA) 1109 (1982).

decision of the Tennessee Chancery Court rendered subsequent to *Commerce Union Bank*, which held that no posthumous right of publicity existed in Tennessee. The court concluded that the two conflicting opinions on the posthumous right of publicity by the state trial court gave the second circuit no basis for considering that Tennessee law had changed since its decision in *Factors II*.⁹¹

In the final analysis, though the *Commerce Union Bank* decision raises some uncertainty, Tennessee appears to follow the California rule and does not recognize a posthumous right of publicity.

6. *The New Jersey Case*

In *Estate of Presley v. Russen*,⁹² the plaintiff estate alleged infringement of Presley's right to publicity. It sought to enjoin exhibition of "The Big El Show," a live stage performance which reproduced an Elvis Presley concert, and the sale of merchandise in connection with the show. Defendant Russen first produced the show in 1975, two years before the entertainer's death, and had not been authorized nor enjoined by Presley himself, nor by any Presley licensee.⁹³

The court stated that New Jersey law would allow a suit for infringement of the right of publicity.⁹⁴ Though the court never addressed the fact that neither Presley nor his licensees had sought to enjoin "The Big El Show" while Presley was alive, it nevertheless found that the celebrity had exploited his right of publicity during his lifetime.⁹⁵ The court held that "Elvis Presley's right of publicity survived his death and became part of Presley's estate."⁹⁶ However, the court did not enjoin the performance of "The Big El Show" because plaintiff estate had failed to show that the show's continuance would result in "loss of commercial benefits" or "irreparable com-

91. The court stated:

The *Lancaster* decision is surely entitled to no less weight than the decision in *Commerce Union Bank* and may even have a special pertinence since it involves a claim by the same parties who are plaintiffs in the instant litigation with respect to a descendible right of publicity concerning Elvis Presley.

Factors Etc., Inc. v. Pro Arts, 701 F.2d 11, 12 (2d Cir. 1983).

92. 513 F. Supp. 1339 (D.N.J. 1981).

93. *Id.* at 1349-50.

94. *Id.* at 1344.

95. *Id.* at 1345.

96. *Id.* In footnote 10 the court stated, "we 'need not, and therefore do not, decide whether the right would survive the death of the celebrity if not exploited during the celebrity's life' since Presley exercised the right to commercially exploit his name and likeness during his life" (quoting *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 222 n.11 (2d Cir. 1978)).

mercial harm in the near future."⁹⁷ The court stated:

The plaintiff has not adequately demonstrated that the existence of defendant's activity has lead to or is likely to lead to a diminished ability of the plaintiff to profit from the use of Elvis Presley's name or likeness. . . . As a matter of fact, it is even possible that defendant's production has stimulated the public's interest in buying Elvis Presley merchandise.⁹⁸

The court did find that irreparable harm would result from the continued merchandising of Elvis memorabilia in connection with "The Big El Show" and enjoined its distribution.⁹⁹

E. Summary

From the foregoing cases it is apparent that the sale of merchandise bearing a deceased celebrity's name and likeness may be enjoined in New York,¹⁰⁰ New Jersey,¹⁰¹ and Georgia.¹⁰² It is also clear that the opportunity to commercially exploit a decedent's right of publicity exists in California, where it can be restricted, if at all, only as to those products the celebrity exploited during life.¹⁰³ Thus, in California if a deceased celebrity had, during life, marketed t-shirts bearing his name and likeness, members of the general public would be prohibited from doing so. However, as to opportunities the celebrity had left unexploited, such as marketing a coffee mug bearing the celebrity's name and likeness, any member of the general public would be free to exploit that opportunity with impunity.

The status of the posthumous right of publicity is less certain in Tennessee. It is possible that Tennessee is more liberal than California and does not recognize a posthumous right of publicity, whether or not the publicity right was exploited during life. Or, Tennessee may follow New York and recognize the right posthumously without regard to lifetime exploitation.¹⁰⁴

The status of the posthumous right of publicity in other jurisdictions can only be determined when the appropriate cases present themselves. Undoubtedly jurisdictions will continue the current trend of following either the California or New York rule. Because public-

97. 513 F. Supp. at 1379.

98. *Id.*

99. *Id.* at 1379-80.

100. See *supra* text accompanying notes 28-34.

101. See *supra* text accompanying notes 92-99.

102. See *supra* text accompanying notes 58-59.

103. See *supra* text accompanying notes 47-54.

104. See *supra* text accompanying notes 71-98.

ity rights are exploited across state lines, the need for national legislation to resolve the issue is imperative.¹⁰⁵

IV. POLICY CONSIDERATIONS FOR THE RECOGNITION OR NON-RECOGNITION OF THE POSTHUMOUS RIGHT OF PUBLICITY.

A number of policy considerations have been advanced in support of the posthumous right of publicity. Most significant are that recognition of a posthumous right of publicity encourages creativity, and that lifetime assignment of the right assures its survival in the celebrity's heirs. Both policies and their related issues will be discussed.

A. *Encouraging Creativity*

The notion that creativity should be rewarded economically has been repeatedly voiced by commentators and the courts. In *Zacchini v. Scripps-Howard Broadcasting*,¹⁰⁶ the United States Supreme Court was particularly concerned with the celebrity's ability to earn a living from an act that was the product of his talent, time and energy.¹⁰⁷

It is plausible to contend that if a living person is not given statutory or common law protection he will not continue to be creative. The likelihood that any celebrity, whether he be an artist, musician, writer, actor, or filmmaker, would continue to be creative in his particular field were he not able to reap the economic benefits of his work is extremely doubtful. A living person, however, can easily protect his right through copyright law¹⁰⁸ and licensing agreements which cover the product of his creative endeavors.

To contend that a *posthumous* right of publicity actually encourages creativity is much less compelling. The Georgia Supreme Court, in *Martin Luther-King, Jr. Center for Social Change v. American Heritage Products*,¹⁰⁹ reasoned that a posthumous right of publicity does encourage creativity. In *King* the court stated that if the right of publicity did not survive the celebrity, it would be diminished during life because the celebrity's untimely death would impair

105. See *infra* section V.

106. 433 U.S. 562 (1977).

107. *Id.* at 575.

108. A discussion of copyright law is beyond the scope of this comment. For a copyright analysis as it affects the posthumous right of publicity, see Felcher & Rubin II, *supra* note 85.

109. 250 Ga. 135, 296 S.E.2d 697 (1982).

or destroy "the value of the right of continued commercial use."¹¹⁰

Because fame and notoriety are so fleeting, however, it is virtually impossible to gauge the value of any celebrity's right of publicity if he were to die suddenly. Celebrities exploit their talents in the free market by means of contracts and licensing agreements. A celebrity's "publicity value" can be calculated using numerous methods. For example, a percentage or a flat fee payment on the sale of merchandise such as books, tee-shirts, and movie tickets, payment of a fee similar to that which like celebrities are paid for like effort, or a profit-sharing agreement are methods by which commercial exploitation may be valued.

The possibility that the person might suffer an untimely death does not necessarily diminish the publicity value during life, for the "value" is derived from sales of the celebrity's "creativity" in the form of merchandise. The revenues from such merchandise fluctuate with public demand. In fact, untimely death may even increase the demand for the celebrity's merchandise.¹¹¹ Thus, giving a person's heirs posthumous control over his publicity rights will not encourage his personal creativity and effort during life.¹¹²

B. *Lifetime Assignment.*

The requirement of making a lifetime assignment of publicity rights as a means of assuring survival of the right in the celebrity's heirs has been examined, at least in dicta, in most of the cases considered herein.¹¹³ There are four lifetime assignment models. In *Price v. Hal Roach Studios*, lifetime assignment is completely unnecessary: failure to exercise one's publicity right during life in order to protect it from use by others does not preclude the celebrity's heirs from inheriting the famous ancestor's publicity right.¹¹⁴

110. 296 S.E.2d at 705.

111. In *Estate of Presley v. Russen*, 513 F. Supp. 1339 (1981), the court stated, "it is even possible that defendant's production [of an impersonation of an Elvis Presley concert after the entertainer's death] has stimulated the public's interest in buying Elvis Presley merchandise or in seeing films or hearing records embodying actual Elvis Presley performances." *Id.* at 1379.

112. For further discussion of posthumous right of publicity as encouraging creativity see, Felcher & Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1618-19 (1979) [hereinafter cited as Felcher & Rubin I].

113. See, e.g., *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975); *Factors Etc., Inc. v. Pro Arts, Inc.* 579 F.2d 215 (2d Cir. 1978), cert. denied, 440 U.S. 908 (1979); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (1981).

114. 400 F. Supp. 836 (S.D.N.Y. 1975).

The second model is illustrated by *Factors I*.¹¹⁵ There, an *inter vivos* assignment of the celebrity's publicity right guarantees that the assignee owns the exclusive right to the celebrity's name and likeness after his death. The court in *Lugosi v. Universal Pictures* articulated model three: lifetime assignment of the right of publicity in connection with a particular product or service insures survival of the right of publicity as to that product or service.¹¹⁶ The most radical model appears in *Memphis Development v. Factors, Etc., Inc.*, where the court held that lifetime assignment is irrelevant, and that a decedent's name and likeness is an economic opportunity available to all in a free market system.¹¹⁷

All of these models present problems. The *Price* scheme, in which no assignment is necessary, leads to the conclusion that even if a publicity right remains unexploited for many generations, extremely remote descendants having no interest in selling tee-shirts bearing the likeness of the ancestor would, nonetheless, be able to stop an enterprising business person from doing so. As an example, should the heirs of Emily Dickinson be able to enjoin the sale of so-called "literary tee-shirts" bearing her name and likeness? Should Paul Revere's heirs be able to enjoin the sale of pots and pans marketed as Revere Ware?

The *Factors I* model, in which lifetime assignment guarantees posthumous survival, raises the issue of whether a person can exploit his heretofore unused publicity right simply by making an assignment or a devise by will. The possibility exists that a celebrity who has never exploited himself through products such as posters or tee-shirts may make a "wholesale" assignment or devise of "all my rights of publicity." However, the assignee may choose to not enter into a commercial venture during the celebrity's life, calculating, perhaps, that the right will be more valuable *after* the celebrity's death. Is the mere assignment or devise sufficient "exploitation" to insure survival of a name and likeness that has never been merchandised? Surely an entrepreneur who would seek to market a tee-shirt or poster using the celebrity's name and likeness would argue that mere assignment or devise by will is insufficient commercial exploitation.

The *Lugosi* model, in which lifetime assignment may assure posthumous survival as to a particular product or service, though the least objectionable model, is subject to two interpretations. It is possi-

115. 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

116. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

117. 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980).

ble that the lifetime exploitation of a celebrity's name and likeness on a product or service would prevent anyone, other than the assignee, from commercially exploiting that product or service posthumously. It is also possible that the assignment can be made only as to a *particular* likeness. Thus, if the celebrity assigns the likeness in a particular photograph to a licensee who will market the likeness on a tee-shirt, that assignment would not prevent a third party from using any *other* photographic likeness of the celebrity in a tee-shirt business.

Lugosi also raises the issue of the disposition of a likeness with a secondary meaning.¹¹⁸ A secondary meaning arises when an individual becomes so closely associated with a character or product that the two become indistinguishable. Thus, *Lugosi* as Count Dracula has a secondary meaning that belongs to Universal Pictures by contractual agreement.¹¹⁹ If a likeness has a secondary meaning, does this prohibit both the heirs and third parties from profiting from its exploitation? For example, could Mark Hamill's heirs market a tee-shirt using a photograph of the actor in his Luke Skywalker make-up and costume, or does such a likeness have a secondary meaning making it the exclusive property or "right of value" of Twentieth Century-Fox and Lucasfilm?

Lifetime assignment also fails to address such issues as what kind of product may be the subject of commercial exploitation, and when an injunction against exploitation will conflict with the first amendment.¹²⁰ Is it permissible to realize profit by naming pots and pans "Revere Ware," an insurance company "John Hancock," a utility "Consolidated Edison," and a pastry "Napoleon,"¹²¹ or does assignment cover only posters, tee-shirts, mugs, and memorabilia? From *Frosch v. Grosset & Dunlap, Inc.*,¹²² *Hicks v. Casablanca Records*,¹²³ *Estate of Presley v. Russen*¹²⁴ and *Groucho Marx Productions v. Day and Night Co.*,¹²⁵ it may be concluded that the sale of books and movies, and impersonations of a famous ancestor cannot be prevented by heirs who claim posthumous infringement of the

118. 25 Cal. 3d at 818, 823, 603 P.2d at 428, 430, 160 Cal. Rptr. at 326, 328.

119. *Id.* at 816 n.2, 603 P.2d at 426 n.2, 160 Cal. Rptr. at 324 n.2.

120. See *supra* notes 36-37 and accompanying text. Consideration of first amendment issues are beyond the scope of this comment. For an analysis of the right of publicity and the first amendment, see *Felcher & Rubin I, supra* note 112.

121. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 959 (6th Cir. 1980).

122. 75 A.D.2d 768, 427 N.Y.S.2d 828 (1980).

123. 464 F. Supp. 426 (S.D.N.Y. 1978).

124. 513 F. Supp. 1339 (D.N.J. 1981).

125. 689 F.2d 317 (2d Cir. 1982).

ancestor's right of publicity. Yet, despite the fact that freedom of expression is protected by the first amendment, movies, books and performances featuring impersonations are profit-making ventures which deprive heirs and assigns of economic benefit to the same degree as do tee-shirts and posters.

Thus, neither the encouragement of creative endeavors nor a lifetime assignment of publicity rights are sound reasons to recognize a posthumous right of publicity.

V. THE JURISDICTIONAL CONFLICT.

A. *The Problem*

Whether exploited by the celebrity himself during life or by his heirs and assigns after death, the mass media is the primary means by which a celebrity's right of publicity is exploited. The market for "celebrity merchandise" is national in scope.¹²⁶ Because "celebrity merchandise" is sold across state lines, the jurisdictional conflict is highly significant.

When a merchandiser is enjoined from selling his product in New York, there is nothing to prevent commercial exploitation of that same product in California. Though the full faith and credit clause of the United States Constitution¹²⁷ mandates that a California court honor a money judgment obtained against the merchandiser in New York, California does not recognize a cause of action for infringement of posthumous right of publicity. Thus, the merchandiser who was enjoined in New York may operate a tee-shirt business in California without fear of liability.

Two examples are illustrative of the need for national legislation regarding the posthumous right of publicity. A merchandiser domiciled in Georgia starts a business selling tee-shirts on which is imprinted the name and likeness of Clark Gable. He advertises the tee-shirts in national editions of *Time* and *Newsweek*. Gable's heirs bring suit in Georgia asserting posthumous infringement of Gable's right of publicity. Despite the fact that Gable never made an assignment during life, they are successful because Georgia recognizes the cause of action without reference to lifetime exploitation. The merchandiser pays the money damages that are assessed and ceases do-

126. Over \$60 billion is spent each year on advertising for radio, television, newspaper, magazines and direct mail. More than half of this sum buys national advertisements. STATISTICAL ABSTRACT OF THE UNITED STATES 566 (103d ed. 1982, 1983).

127. U.S. CONST. art. IV, § 1, cl. 1.

ing business in Georgia. Two months later the merchandiser incorporates a Clark Gable tee-shirt business in California and advertises through the same national media. The merchandiser is engaged in a lawful business in California and Gable's heirs are powerless to stop his profit-making endeavors.

Another scenario involves the production of a Broadway play satirizing the life of a famous, deceased celebrity. The celebrity's heirs bring suit in New York against the producers, who refuse to pay the heirs a royalty fee, alleging infringement of celebrity's posthumous publicity rights. The heirs prevail in court. The producers, however, form a road company of the show and exhibit the production in California. Again, the heirs are powerless to prevent commercial exploitation of the play because California does not recognize a posthumous infringement action.

These two examples demonstrate the need for a uniform law. Without a uniform act, exhibitors and merchandisers will be forced to place advertisements for their products only in editions of the national media that circulate or are broadcast in those states which do *not* recognize a posthumous right of publicity. Without national legislation, producers and merchandisers will be subject to suit in each state in which they do business where the courts have not yet spoken, to determine whether they can continue business in those states.

Without a uniform act, efficient interstate commerce is hampered and may, in some cases, be completely inhibited because merchandisers and producers may be unwilling to enter a commercial venture using a deceased celebrity's name and likeness due to the threat of legal action and the attendant difficulties of state by state, rather than national business planning.

B. *The Solution*

The court suggested in *Memphis Development v. Factors Etc., Inc.* that there should be an "equal distribution of the opportunity" to exploit a deceased celebrity's right of publicity.¹²⁸ The adoption of a uniform national act, though not as expansive as Judge Merritt's proposal, would offer protection for merchandisers without depriving the heirs of a valid assignment of rights.

The proposed statute should be adopted as the second paragraph of section 652C of the Restatement of Torts. The proposed wording is set forth herein:

128. 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980).

The right of publicity is a personal right which does not survive the death of the owner. The right may be assigned or devised *inter vivos* by evidence of significant commercial exploitation. Such assignment or devise is effective posthumously and may be enforced only by the immediate heirs or assigns solely to the extent of the particular likeness assigned. The right of publicity may not be assigned or devised by means of a grant in all rights to every likeness.

The proposed legislation states that the right of publicity is a personal right which does not descend unless there has been a lifetime assignment to an assignee who has commercially exploited the right. To permit otherwise would encourage waiting for the celebrity to die before commercial exploitation takes place. The statute places the right in immediate heirs or assigns, thereby preventing remote heirs or assigns from enjoining a business that uses the name and likeness of a celebrity whose publicity right would ordinarily be in the public domain. Lastly, the legislation is designed to vest in the heirs or assigns only the particular likeness of the celebrity ancestor that was exploited during life, and to prevent the "wholesale" devise of "all my rights of publicity to all my likenesses in all products." This last feature is particularly significant because it allows merchandisers to market a tee-shirt or poster bearing a celebrity's name and likeness, even though his heirs and assigns are also doing so, so long as the likeness used by the merchandiser is not the subject of the assignment made by the celebrity.

VI. CONCLUSION

As each suit alleging infringement of an ancestor's right of publicity is brought, courts will be forced to choose between the California rule, which does not recognize the right, and the New York rule, which does. Thus, the jurisdictional split will continue. As a result, a merchandiser who seeks to market a deceased celebrity's likeness on a tee-shirt will be free to do so in some states, prohibited in others, and permitted to do so in yet another group of states only if a particular *inter vivos* assignment was made. The jurisdictional split will be exacerbated when each jurisdiction that recognized a posthumous publicity right chooses a different *inter vivos* assignment model.

Adoption of the proposed uniform act will promote efficient use of interstate commerce to exploit posthumous publicity rights. The proposed act does not recognize a posthumous right of publicity.

However, it provides protection for merchandisers without depriving the heirs of a valid assignment of rights.

Leslie Kane